

REMARKS

In view of the above amendment, Applicants believes the pending application is in condition for allowance.

Claims 1, 3-7, 9-12, and 14-16 are now present in this application, of which claims 1, 7, and 12 are independent. By this amendment, claims 2, 8, and 13 have been canceled, without prejudice or disclaimer, and claims 1, 3-7, 9-12, and 14-16 have been amended.

Reconsideration of this application, as amended, is respectfully requested.

Priority Under 35 U.S.C. § 119

Applicants thank the Examiner for acknowledging Applicants' claim for foreign priority under 35 U.S.C. § 119, and receipt of the certified priority document.

Information Disclosure Citation

Applicants thank the Examiner for considering the reference supplied with the Information Disclosure Statement filed February 12, 2004, and for providing Applicants with an initialed copy of the PTO-1449 form filed therewith.

Drawings

Since no objection has been received, Applicants assumes that the drawings are acceptable and that no further action is necessary. Confirmation thereof in the next Office Action is respectfully requested.

Rejection Under 35 U.S.C. § 112, 1st Paragraph

Claims 1-16 stand rejected under 35 U.S.C. § 112, 1st Paragraph. This rejection is respectfully traversed.

The Examiner states that claims 1, 7, and 12 require that the lubricating oil tank be positioned above the reservoir that contains the lubricating oil at the bottom portion of the crankcase and that claims 4, 10, and 15 allegedly contradict this relationship by requiring the lubricating oil tank be disposed in the lowermost portion of the crankcase.

By this amendment, claims 4, 10, and 15 have been amended to recite a combination of elements wherein "an oil sump is disposed in a lowermost portion of said crankcase" thereby mooting this rejection. Support for this claimed arrangement can be found for example in Figs. 8 and 10 (oil sumps 67j and 71j) and paragraphs [00072], [00077], and [000118].

In addition, the Examiner states that claims 1, 7, and 12 require that the lubricating oil tank be formed within the crankcase and that claims 3, 9, and 14 reciting that the lubricating oil tank is formed along an outside wall of the crankcase contradicts independent claims 1, 7, and 12. Applicants respectfully note that a fair reading of dependent claims 3, 9, and 14 does not require that the lubricating oil tank be formed outside of the crankcase. If claims 3, 9, and 14 had been written to recite "along an outside surface", one could understand the confusion, but here the claims set forth a combination of elements wherein a lubricating oil tank formed integral with a crankcase and be formed along an outside wall. Furthermore, support for the claims as written is found for example in Fig. 10 and paragraph [000129]. Therefore, Applicants respectfully request that the Examiner withdraw this particular rejection.

Rejection Under 35 U.S.C. § 112, 2nd Paragraph

Claims 1-16 stand rejected under 35 U.S.C. § 112, 2nd Paragraph. This rejection is respectfully traversed.

The Examiner has set forth certain instances wherein the claim language lacks antecedent basis or is not clearly understood.

In order to overcome this rejection, Applicants have amended claims 1, 6, 7, and 12 to correct each of the deficiencies specifically pointed out by the Examiner. Applicants respectfully submit that the claims, as amended, particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Support for these amendments can be found for example in Figs. 7, 10, and 34 and in paragraphs [00074], [00075], [00080] to [00082] and [000129].

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

Rejections Under 35 U.S.C. §§ 102 and 103

Claims 1, 7, and 12 stand rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,682,851 to Breen et al. ("Breen"); claims 1, 2, 7, 8, 12, and 13 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2002/0043232 A1 to Katayama; and claims 7, 8, 10-13, 15, and 16 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0079710 A1 to Webster et al. ("Webster"). Furthermore, claims 1, 2, 4, and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Webster; claims 3, 9, and 14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Breen, Katayama, or Webster; and claim 6 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Breen or Katayama. These rejections are respectfully traversed.

Complete discussions of the Examiner's rejections are set forth in the Office Action, and are not being repeated here.

In light of the foregoing amendments, Applicants respectfully submit that these rejections have been obviated and/or rendered moot. While not conceding to the Examiner's rejections, but merely to expedite prosecution, as the Examiner will note, independent claims 1, 7, and 12 have been amended.

Independent claims 1 and 7 are directed to a combination of elements wherein lubricating systems for internal combustion engines are provided that include, *inter alia*, "an overflow oil passage wall projecting from said inside wall of said crank chamber extends downwardly" and "an overflow oil passage formed in said tank wall partition and said overflow oil passage wall extending substantially parallel to said tank partition wall, through which said lubricating oil that flows over the upper edge of said overflow oil passage wall of said lubricating oil tank is led to said pump suction port of said recovery pump."

Independent claim 13 is directed to a combination of elements wherein a lubricating system is adapted for use with an internal combustion engine including, *inter alia*, "an overflow oil passage wall projecting from said inside wall of said crank chamber extends downwardly" and "an overflow oil passage formed in said tank partition wall and said overflow oil passage wall extending substantially parallel to said tank partition wall, through which said lubricating oil

that flows over the upper edge of said tank partition wall of said lubricating oil tank is led to the pump suction port of said recovery pump.”

Applicants respectfully submit that none of the references used by the Examiner, taken either singly or in combination, teach or suggest the present invention as set forth in independent claims 1, 7, and 12.

Webster

Webster discloses a housing 12 divided into a crankshaft chamber 90 and a clutch chamber 84 separated by a dividing wall 46. The dividing wall 46 includes an overflow opening 52. *See* Fig. 7 and paragraphs [0019] and [0022]. Webster fails to teach or suggest an overflow oil passage formed in a tank wall partition and an overflow oil passage wall extending substantially parallel to the tank partition wall, through which the lubricating oil that flows over the upper edge of the overflow oil passage wall of the lubricating oil tank is led to the pump suction port of the recovery pump.

Because Webster does not teach or suggest the claimed overflow oil passage, independent claims 1, 7, and 12 are allowable over Webster.

Breen

Breen discloses an oil system for an engine, but as the Examiner implicitly acknowledges, Breen does not disclose overflow oil passage formed in a tank wall partition and an overflow oil passage wall extending substantially parallel to the tank partition wall, through which the lubricating oil that flows over the upper edge of the overflow oil passage wall of the lubricating oil tank is led to the pump suction port of the recovery pump. In particular, the Examiner does not reject original claims 2, 8, and 13 over Breen under either of 35 U.S.C. § 102(e) and of 35 U.S.C. § 103(a).

Because Breen does not teach or suggest the claimed overflow oil passage, independent claims 1, 7, and 12 are allowable over Breen.

Katayama

Katayama also discloses an engine lubrication system. However, while Fig. 15 shows an overflow passage 376, Katayama is silent as to the physical structure of the overflow passage and the Examiner has failed to identify the particular structure that is alleged to be an oil overflow passage. Therefore, Katayama cannot teach or suggest the claimed oil overflow passage as recited in independent claims 1, 7, and 12, and therefore these claims are allowable over Katayama.

Inherency

The Examiner has relied heavily on inherency regarding the particulars of a partition wall and the existence of an oil overflow passage having an oil overflow wall. However, the Examiner has not provided any evidence or other showing indicating the limitations set forth in claims 1, 7, and 12 would be inherent. As indicated in the M.P.E.P. at section 2112, "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." (citations omitted)(emphasis in original). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999)(citation omitted). Since the Examiner has not cited any extrinsic evidence to clearly show that certain features of claims 1, 7, and 12 are "necessarily present" in the cited references, Applicant respectfully request the examiner to withdraw the claim rejection based on inherency for claims 1, 7, and 12.

In particular, as noted above, Webster fails to teach or suggest the particulars of the claimed oil overflow passage and as a result such structure cannot be inherently provided for in Breen and Katayama.

Official Notice

Moreover, in rejecting claim 1, 2, 4, and 5 under 35 U.S.C. § 103(a) as being unpatentable over Webster, the Examiner takes Official Notice “the fact that supplying an additional pump (or usually named “auxiliary pump”) in engines is known in the engine lubrication art.

While it may be known to provide an “auxiliary pump”, the Examiner has not established that it is obvious to provide both “a recovery pump by which lubricating oil dropping to and dwelling in a bottom portion of said crankcase after lubricating individual portions of said internal combustion engine is sucked through a pump suction port opened in said bottom portion of said crankcase and is fed to said lubricating oil tank” and “a supply pump for supplying said lubricating oil from said oil tank to said individual portions of said internal combustion engine.” The Examiner is not free to ignore the further limitation defining the recovery pump and supply pump when taking “Official Notice.” Furthermore, M.P.E.P. § 2144.03 states:

If the applicant traverses such an assertion the examiner should cite a reference in support of his or her position.

When a rejection is based on facts within the personal knowledge of the examiner, the data should be stated as specifically as possible, and the facts must be supported, when called for by the applicant, by an affidavit from the examiner.

Applicants respectfully request that the Examiner provide the evidence required under this Section of the M.P.E.P. so that Applicants can properly respond to the rejection. In addition to providing a teaching of the claimed recovery pump and supply pump, the Examiner must still provide motivation for further modifying Webster to include a supply pump.

For the foregoing reasons, independent claims 1, 7, and 12 are allowable over the cited references and the rejections must be withdrawn.

With regard to dependent claims 3-6, 9-11, 14-16, Applicants submit that these claims depend, either directly or indirectly, from one of independent claims 1, 7, and 12, which are allowable for the reasons set forth above, and therefore these claims are allowable based on their dependence from one of claims 1, 7, and 12, as well as for their additionally recited subject matter.

Reconsideration and allowance thereof are respectfully requested.

Additional Cited References

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

Office Action

The Office Action contains numerous characterizations of the invention, the claims, and the related art, with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Chad D. Wells, Registration No. 50,875, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

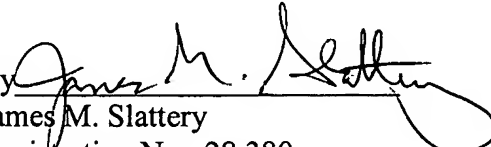
Application No. 10/660,577
Amendment filed November 28, 2006
Reply to Office Action of September 6, 2006

Docket No.: 0505-1246P
Page 13 of 13

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Dated: November 28, 2006

Respectfully submitted,

By 
James M. Slattery
Registration No.: 28,380
BIRCH, STEWART, KOLASCH & BIRCH, LLP
8110 Gatehouse Road
Suite 100 East
P.O. Box 747
Falls Church, Virginia 22040-0747
(703) 205-8000
Attorney for Applicants

CDW